

REMARKS

Finality of the Office Action

Applicants respectfully request that the finality of the Office Action be withdrawn. The Office Action summarily states that the new rejections were necessitated by Applicants amendment. Applicants respectfully contest this assertion. The new rejections, particularly those relying on the 2 new Monia references, which have heretofore never been of record appear to be entirely *de novo*, not necessitated by Applicants amendments, and incapable of having been addressed by Applicants until this late stage in the proceedings.

Claims Amendments

Claims 1 and 16-18 were pending previously herein. Claims 1 and 3-5 have been canceled herein. Claims 16-18 have been amended herein to recite a modified CpG-containing oligonucleotide wherein all CpG dinucleotides present in the oligonucleotide are modified at the C and/or G with a 2'-O-methyl moiety. Support for this amendment can be found in the specificationat page 11 lines 26-28. No new matter has been added.

Novelty

All presently maintained novelty rejections are directed to claim 1. Claim 1 has been canceled, thereby rendering these rejections moot.

Obviousness

Claims 16-18 are rejected under 35 U.S.C. §103(a), as being unpatentable over Kawasaki et al in view of Agrawal et al and Shilltoe et al and over Monia et al (US Patent 5,563,255). Both of these rejections suffer from the same deficiency. In each case, they ignore the unexpected property of the methods of claim 16-18 that reduced side effects are achieved.

The oligonucleotides of Kawasaki and Monia fortuitously contained a single CpG that was modified by a 2'-O-methyl group. However, it was neither known nor obvious to one skilled in the art that such modifications of the oligonucleotides would reduce side effects. The only assertion that could be made by the PTO is that this claim limitation would have been inherent that the use of the oligonucleotides of Kawasaki or Monia in Applicants claimed method

would result in reduced side effects. In the context of an obviousness rejection however, the use of an inherent property of a prior art compound in the rejection of a claimed process is only proper if the inherency of such a feature would have been known or obvious at the time the invention was made.

See for, example, *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986).

Stora bases a major argument on the undisputed fact that size change uniformity is an inherent property of the alloy disclosed in the '518 patent. That argument is unpersuasive when confronted by Stora's failure to establish at trial that that inherency would have been obvious to those skilled in the art when the invention of claim 4 was made.

Inherency and obviousness are distinct concepts. *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1555, 220 USPQ 303, 314 (Fed. Cir. 1983) (citing *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (1966)), *cert. denied*, 469 U.S. 851, 105 S.Ct. 172, 83 L. Ed.2d 107 (1984).

See also *In re Dillon*, 919 F.2d 688 (Fed. Cir. 1990).

The board stated that it is inherent in Dillon's compositions that they would reduce particulate emissions, that Dillon "merely recited a newly discovered function inherently possessed" by the prior art. Arguments based on "inherent" properties can not stand when there is no supporting teaching in the prior art. Inherency and obviousness are distinct concepts. *In re Spormann*, 363 F.2d 444, 448, 53 CCPA 1375, 150 USPQ 449, 452 (CCPA 1966):

[T]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

Thus where, as here, the use of a compound having features, purported by the PTO to be inherent, that were unknown in a claimed method that recites such unknown (and thus unexpected) features are not obvious and thus the claimed method is not obvious.

Accordingly, Applicants respectfully request that this rejection be withdrawn

CONCLUSION

In view of the above remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner believes that any discussion of this communication would be helpful, the Examiner is invited to call the undersigned attorney at 781-933-6630.

Respectfully submitted,

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